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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,235	09/29/2003	Rudolph Nobis	END5214USNP	1897
27777 7590 05/14/2009 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3734				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/674,235

Applicant(s)

NOBIS ET AL.

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-12 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action is in response to the RCE filed on 2/17/2009.

Claims 1-12 are pending in this present application.

Claim Objections

2. Claims 1-12 are objected to because of the following informalities: Applicant uses “actuating mechanism” and “actuator mechanism” interchangeably to refer to the same element throughout the claims. Applicant should change them all to either “actuating mechanism” or all to “actuator mechanism”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 2, 3, 7 and 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 4, “second member” should be – second position --.

Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites “the gripping engagement” in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 8 and 12 are rejected under 35 U.S.C. 102(c) as being anticipated by Gadberry et al (7,025,775).

Regarding claim 1, Gadberry et al disclose a medical device comprising: a flexible shaft 18 comprising a pulling member 43 movable therein, the flexible shaft having sufficient flexibility to be formed into an operable, looped configuration during use, (Note: it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987)); an actuating mechanism 27 operatively associated with a proximal end of the flexible shaft; an end effector 21 associated with the distal end of the flexible shaft, wherein the end effector is operatively associated with a distal end of the pulling member; and wherein the actuator mechanism has a first configuration (fig. 2) in which the actuator mechanism is decoupled from the pulling member, and a second configuration (fig. 5) wherein the actuator mechanism becomes operatively coupled to the pulling member to operate the end effector.

Regarding claim 2: Gadberry et al disclose the actuator mechanism comprises an actuator 29 movable from a first position (fig. 2) wherein the actuator mechanism is decoupled from the pulling member to a second member 34 wherein the actuator mechanism 27 becomes operatively coupled to the pulling member.

Regarding claim 3: Gadberry et al disclose the actuator is movable from the second position (fig. 5) to a third position (when the handles are at least partially closed) wherein the end effector is operated.

Regarding claim 8: Gadberry et al disclose a proximal end of the pulling member 43 is joined to a relatively larger diameter member 47, and wherein the actuator mechanism engages the relatively larger diameter member to provide coupling of the actuator mechanism to the pulling member.

Regarding claim 12: Gadberry et al disclose wherein the end effector is selected from the group consisting of a biopsy forceps, grasping forceps, surgical scissors 21 (see col. 2, lines 59-60), extractors, and snares.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gadberry et al in view of Hancock et al (5,647,686). Gadberry et al disclose the invention substantially as claimed except for the actuating mechanism comprising a resilient member, such as a torsion spring, for coupling the actuation member to the pulling member.

Hancock et al disclose a coupling comprising the resilient member in the form of a torsion spring (see fig. 6, element 9) for quickly joining a rod or shaft to another element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the actuating mechanism of Gadberry with a coupling comprising a torsion spring as taught by Hancock in order to facilitate a quick connection of the pulling member to the actuating mechanism.

Allowable Subject Matter

5. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art of record, alone or in combination, discloses or suggests wherein the actuator is movable from the first position to the second position by squeezing with a single hand.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Pat. No. U.S. 4,714,075 to Krauter and U.S. Pat. No. U.S. 5,049,153 to Nakao. US 2004/0021276 to Allan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VN/

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734